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January 3, 2007

Commissioner for Patents  
Mail Stop: **Appeal Brief**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

**Re: U.S. Patent Application No. 10/733,516**  
**For: DUAL SLAVE PISTON FOR VARIABLE VALVE**  
**ACTUATION SYSTEM**  
**JVS Reference No.: DP-470**  
**Our Reference No.: 34090-06297**

Transmitted herewith for filing in the U.S. Patent and Trademark Office in connection with the above-referenced application are the following documents:

- (1) Transmittal Form (1 page); and
- (2) Reply Brief (3 pages).

Please date-stamp the enclosed copy of this letter, thereby acknowledging receipt of the above-identified documents.

Sincerely yours,

DAVID R. YOHANNAN, Reg. No. 37,480

Enclosures

DRY/gw



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10733,516	
	Filing Date	December 12, 2003	
	First Named Inventor	Ruggiero, Brian	
	Art Unit	3748	
	Examiner Name	Z. Eshete	
Total Number of Pages in This Submission	4	Attorney Docket Number	34090-06297

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks</b>		
<b>SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT</b>		
Firm Name	KELLEY DRYE & WARREN, LLP	
Signature		
Printed name	DAVID R. YOHANNAN	
Date	January 3, 2007	Reg. No. 37,480

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re

Application of: Brian Ruggiero

Serial No.: 10/733,516

Examiner: Z. Eshete

Filed: December 12, 2003

Group Art Unit: 3748

For: MULTIPLE SLAVE PISTON VALVE ACTUATION SYSTEM

Attorney Docket: 34090-06297

REPLY BRIEF

MAIL STOP APPEAL BRIEF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer dated November 14, 2006, and pursuant to 37 C.F.R. §§ 41.41, Appellant submits the following Reply Brief.

The Examiner's response to Appellant's arguments is faulty both legally and on the facts. In rebuttal to Appellant's arguments, the Examiner relies on the holding that "[n]on-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." In re Merck & Co., Inc., 800 F.2d 1091, 1097 (Fed. Cir. 1986). The Examiner uses this statement to support the proposition that Appellant is barred from pointing out deficiencies in individual prior art references when the rejection at issue is based on a combination of references. The Examiner's proposition far exceeds the holding in In re Merck. The foregoing quote from In re Merck was explained in that opinion to merely mean that when a rejection is based on a combination of references, an individual reference "must

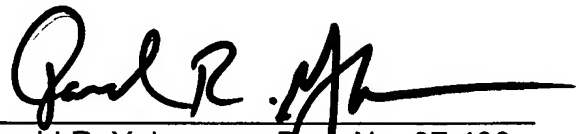
be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” Id. This holding does not conflict with, or eviscerate in any way, the requirement that the prior art references, when combined, must teach or suggest all the claim limitations. See MPEP § 2143.03; In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Accordingly, Applicant may attack a reference used in a combination if the reference does not in fact teach what it is asserted to teach, which is the case in the present appeal.

The factual deficiency of the rejection at issue is related to its express reliance on figures 1 and 10 of U.S. Patent No. 6,386,160 to Meneely et al. (hereinafter “Meneely”) for teaching “a valve bridge disposed between the first and second slave pistons and the two engine valves; wherein the first distance is different than the second distance,” wherein the first distance is the space between the engine valves and the second distance is the space between the slave pistons. See Examiner’s Answer at 4. This rejection is faulty because Meneely simply does not disclose two “slave” pistons separated by any distance, and therefore cannot provide the asserted teaching.

The fact that Meneely fails to disclose two slave pistons is explained in detail in Appellant’s Appeal Brief and supported by the specification of the application at issue. Further support of the well-understood meaning of the term “slave piston” in the engine braking arts is evidenced by its use in U.S. Patent No. 3,220,392 to Cummins (hereinafter “Cummins”). Cummins discloses that a “slave” piston is one that is moved hydraulically by an associated “master” piston. See Cummins at column 8, lines 61-70. Two such “slave” pistons are not disclosed in the Meneely embodiments relied upon.

Appellant notes with appreciation that Claim 23 is now allowed and Claim 4 is indicated to be allowable. In light of the above arguments, Appellant respectfully submits to the Board that the remaining rejections are untenable, and the Application is in condition for allowance with all pending claims.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "David R. Yohannan", with a long horizontal flourish extending to the right.

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Dated: January 3, 2007